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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,629	05/13/2001	Mary Lou Floyd	308,650	5777
<div>7590 11/17/2008 ABELMAN FRAYNE &amp; SCHWAB 666 Third Avenue 10th Floor New York, NY 10017-5621</div>				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/681,629

**Applicant(s)**

FLOYD, MARY LOU

**Examiner**

MARK FADOK

**Art Unit**

3625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Response to Remarks***

The examiner is in receipt of applicant's response to office action mailed 5/12/2008 which was received 10/14/2008. Acknowledgement is made that no amendments were made to the application. Applicant's remarks have been carefully considered and are convincing in regards to the Double Patenting rejection, however in regards to the USC 112 rejection and ejection on the merits the previous rejection stands and is restated below:

**Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6,14 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant broadly claims an interactive television environment (original claim 1). The specification only mentions that television relies on brand name sponsorship (para 0038 in applicant's PG PUB US 20020169676). Applicant's specification further states in para 0004 and 0005 that the web page can be accessed by a computer or other user device. This broad definition can include a person watching TV and accessing a brand by a computer or other online device, but does not support that the device is an interactive television.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 3,4,5,7-13,15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkowski (US 5,950,173).**

In regards to claims 3,4,5,7-13,15-17, Perkowski teaches all the features of the instant claims: For instance, Perkowski discloses a first IPI website where a URL sends a search for brand name URLs (col 14, lines 18-52). Inputting a trademark or company name (brand name) into a search (FIG 5B) and returning applicable URLs pointing to web content on the internet (FIG 6A).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6,14,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski in view of Official Notice.**

In regards to claims 6, 14 and 18, Perkowski teaches inputting a brand name into a computer, but does not specifically mention that the device is an interactive television. The examiner takes official notice that it was old and well known in the art at the time of the invention to use interactive televisions for inputting search information. It would have been obvious to a person of ordinary Skill in the art at the time of the invention to include in Perkowski the use of the input functionality in interactive televisions, because this will increase the revenue to the company by not excluding the interactive televisions from using brand names while searching the internet.

***Response to Arguments***

Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive.

Applicant argues that a computer is synonymous with the term "interactive television". The examiner disagrees for several reasons. 1) applicant's own amended disclosure emphasized in the amended specification that "the device 12 may be a computer and/or an interactive television." Clearly applicant is making a distinction

between a computer and an interactive television. 2). Per MPEP para 7.34.02 Terminology Used Inconsistent with Accepted Meaning. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Applicant tries now to redefine the meaning, however one of ordinary skill in the art would recognize the ordinary meaning of a interactive television to be a television with some type of computing device attached such as a set top box that makes an ordinary television interactive.

In response to applicant's argument that Perkowski includes additional structure (UPN, UPC USN or EAN) and therefore teaches away because this structure is not required by applicant's invention, it must be noted that Perkowski disclosed the invention as claimed. The fact that it discloses additional structure is irrelevant.

Applicant argues that Perkowski does not teach a device for inputting a user-selected brand name, or a step of first inputting a user selected brand name (please note that there is no implied sequence steps provided in the instant claims) or outputting a first URL which provides information about a product corresponding to the inputted user-selected brand name. The examiner disagrees and further directs applicant's attention to col 31, line 31- col 32 line 35 and FIGs 4A1 and 6B, where the subject features are clearly taught.

Applicant argues that Perkowski only inputs requests using barcodes and a scanner. The examiner disagrees and directs applicant's attention to col 31, line 31- col 32 line 35 and FIGs 4A1 and 6B where it is clearly taught that a Trademark or company name, brand name such as Coca Cola is entered into the client browser and a URL of the product is returned to the user.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., searching does not include a search with a UPN) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., only searching for matched brand names to output and corresponding URL) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case the claim recites searching only a plurality of brand names for a first match of the inputted user-selected brand name with a matching brand name. When the brand name is inputted, for instance "Crest", only the corresponding trade/ service marks will be searched and corresponding URL will be provided (see at least FIG 6A and 4A1).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., client does not have to input or pay to have the URL listed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300** [Official communications; including  
After Final communications labeled  
"Box AF"]

For general questions the receptionist can be reached at  
**571.272.3600**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/  
Primary Examiner, Art Unit 3625

